

REMARKS

Entry of the foregoing and reexamination and reconsideration of the subject application, as amended, pursuant to and consistent with 37 C.F.R. § 112, are respectfully requested in light of the following remarks.

Claims 10-25 remain present in this application. Claims 1-9 were previously cancelled. Claim 10 has been amended to recite that in the definition of M in POS (III), w = 0 and x = 3 and in the definition of D, y = 1 and z = 1. Therefore, in POS (III), M = $(R^4)_3SiO_{1/2}$ and D = $(X)(R^5)SiO_{2/2}$.

No new matter has been introduced as a result of the foregoing amendments.

35 U.S.C. §102(b) prior art rejection

Claims 10-5 and 17-25 have been rejected under 35 U.S.C. §102(b) as being anticipated by Ikeno et al. (U.S. Patent No. 4,990,560).

It is well established that in order to demonstrate anticipation over 35 U.S.C. § 102(b), each feature of the claim at issue must be found, either expressly described or under principles of inherency, in a single prior art reference. See, *Kalman v. Kimberly-Clark Corp.*, 218 USPQ 789 (Fed. Cir. 1983).

Ikeno does not disclose the at least one monofunctional polyorganosiloxane POS (III) containing: a) identical or different endgroup siloxyl units of type M = $(R^4)_3SiO_{1/2}$ and b) at least one siloxyl unit D = $(X)(R^5)SiO_{2/2}$. Therefore Claim 10 and claims which depend from claim 10 are not anticipated by Ikeno.

Applicants respectfully submit that the claims are not anticipated by Ikeno et al. and the rejection should be withdrawn.

35 U.S.C. §103(a) Obviousness Rejections

Claims 16 has been rejected under 35 U.S.C. §103(a) as unpatentable over Ikeno et al. (U.S. Patent 4,990,560).

Applicant respectfully submits that Claim 16 is not obvious over Ikeno.

To establish a *prima facie* case of obviousness, three basic criteria must be met. (MPEP 2143) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The Office Action acknowledges that Ikeno appears only to contemplate a one-part composition, but alleges that a two-part composition is always obvious where a curable one-part composition is described and that composition may be susceptible to premature curing, as is known to occur with hydrosilylation-curable compositions under ambient conditions. Ikeno does not teach or suggest that their composition is susceptible to premature curing under ambient conditions. In fact Ikeno teaches heating the compositions to 150°C for one hour in the examples. (col. 7, lines 36-37)

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. There is no suggestion or motivation in Ikeno or in the knowledge generally available to one of ordinary skill in the art to modify Ikeno to use the claimed constituent (C) which comprises at least one monofunctional polyorganosiloxane POS (III) containing: a) identical or different endgroup siloxyl units of type $M = (R^4)_3SiO_{1/2}$ and b) at least one siloxyl unit $D = (X)(R^5)SiO_{2/2}$. Therefore there is no motivation or suggestion in the cited prior art to modify the invention of Ikeno to obtain Applicant's invention.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Ikeno does not teach or suggest using at least one monofunctional polyorganosiloxane POS (III) containing: a) identical or different endgroup siloxyl units of type $M = (R^4)_3SiO_{1/2}$ and b) at least one siloxyl unit $D = (X)(R^5)SiO_{2/2}$ as required by the claims. Therefore the cited prior art does not teach or suggest all of the limitations of the instant claims.

Therefore, in consideration of the foregoing, Applicants respectfully submit that Claim 16 is not obvious over Ikeno. Applicants therefore request that this rejection be withdrawn.

In view of the foregoing, it is believed that entry of the proposed amendments should be allowed and that the record rejections cannot be maintained against the proposed claims once entered into this application. Further, favorable action in the form of a Notice of Allowance is believed to be next in order and is earnestly solicited.

Respectfully submitted,

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